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|   |   |                     |
|---|---|---------------------|
| In re Application of:                       | : |                     |
| KOHL, Paul, et al.                          | : | DECISION ON RENEWED |
| U.S. Application No.: 10/590,264            | : | REQUEST UNDER       |
| PCT No.: PCT/US2005/005088                  | : | 37 CFR 1.497(d)     |
| International Filing Date: 16 February 2005 | : |                     |
| Priority Date: 19 February 2004             | : |                     |
| Attorney's Docket No.: 36157/1.9            | : |                     |
| For: MICROSTRUCTURES AND                    | : |                     |
| METHODS OF FABRICATION                      | : |                     |
| THEREOF                                     | : |                     |

This decision is issued in response to the "Renewed Request Under 37 CFR 1.497(d)" filed 16 January 2008. Applicants have submitted the required extension fee.

**BACKGROUND**

In a decision mailed on 06 September 2007, applicants' request to correct inventorship under 37 CFR 1.497(d) was dismissed without prejudice for failure to satisfy all the requirements of a grantable request. Specifically, the filed declaration appeared to be an unacceptable compilation of multiple declarations, and applicants had not provided the consent of the assignee to the requested change of inventorship, as required under 37 CFR 1.497(d)(3).

On 16 January 2008, applicants filed the "Renewed Request Under 37 CFR 1.497(d)" considered herein (with required extension fees).

**DISCUSSION**

**1. Compiled Declaration**

The present submission includes copies of complete three-page declarations executed by each of the three signing inventors. The submission of these complete declarations resolves the compilation defect identified in the previous decision.

**2. Consent of the Assignee**

At the time the present submission was filed, an assignment document identifying the assignee as Georgia Tech Research Corporation was recorded in the USPTO.

The present submission includes a document entitled "Statement of Assignee Consent To File A Declaration Pursuant To 35 U.S.C. 371(c)(4) Naming An Inventive Entity Different From The Inventive Entity Set Forth In The International Application" (hereinafter "Statement of Assignee Consent") which states that Georgia Tech Research Corporation, as designated assignee of the present application, consents to the requested removal of Justin L. Tullis as an inventor of record. The statement is signed by Kevin L. Wozniak, identified as "Director, Office of Technology Licensing."

The materials filed with the present submission do not, however, satisfy the requirements of 37 CFR 1.497(d)(3). As noted in the previous decision, the assignee's consent must be submitted in compliance with 37 CFR 3.73(b) (see MPEP § 201.03(II)(D)). The present submission does not satisfy the requirements of 37 CFR 3.73(b)(1) and (2). Specifically, with respect to 3.73(b)(1), applicants have not provided a statement from the assignee that "the documentary evidence of the chain of title from the original owner to the assignee was or concurrently is being submitted for recordation" or that "documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number)." With respect to 3.73(b)(2), the person signing the Statement of Assignee Consent does not expressly state that he is authorized to act on behalf of the assignee, and his title as "Director" does not provide apparent authority to act on behalf of the assignee. See MPEP § 324(V): "An officer (chief executive officer, president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director."

Because the consent of the assignee has not been submitted in compliance with the requirements of 37 CFR 3.73(b)(1) and (2), on the present record, the Statement of Assignee Consent cannot be accepted in satisfaction of the requirements of 37 CFR 1.497(d)(3). This element of a grantable request under 37 CFR 1.497(d) therefore remains unsatisfied.

### **CONCLUSION**

Applicants' renewed request to correct inventorship under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The declaration filed with the present submission on 16 January 2008 is defective for failure to properly identify the inventors of record herein.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Second Renewed Request Under 37 CFR 1.497(d)" and must include the materials required to satisfy the requirements of 37 CFR 1.497(d)(3) (i.e., the consent of the assignee in the form required by 37 CFR 3.73(b)), as discussed above and in the MPEP.

Failure to file a proper response will result in abandonment of the application. Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'rllr'.

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